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REMARKS

The present amendment is responsive to the Office Action mailed in the above-referenced case on September 19, 2007.

Response to Arguments

The examiner kindly provides a detailed response to applicant's arguments, stating, among other points, that applicant does not specify in either the disclosure or the claims what the applicant means by juncture. The applicant urges the examiner to consider, as he has not yet done, claims other than the broadest claim. Claim 53 recites "wherein the juncture comprises a MacPherson strut dome in a vehicle body assembly." Claim 54 recites "wherein the juncture comprises a vehicle roof and a roof bow in a vehicle body assembly." Claim 55 recites "wherein the juncture comprises aligned openings in two metal parts joined by a peg or other rigid connective element." Moreover all the drawings in applicant's application, being a part of the disclosure, and the text description of those drawings specify the nature of what applicant means by "juncture" and what applicant means by "shaped to conform".

Rejection Under 35 U.S.C. § 102

6. Claims 56-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Cleslik (EP 0 453 777 A2)

Applicant's Response

The examiner has interpreted applicant's language in the broadest possible way, evidently without too much regard to the meaning of the terms of the claims as defined in applicant's specification.

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Accordingly the applicant has amended claim 50 to recite:

50. A method for providing corrosion protection in an assembly of two or more metal parts, comprising the steps of:

(a) given two metal parts to be joined, but not yet joined, placing a corrosion-protection element comprising heat-expandable material proximate one of the parts to be joined;

(b) joining the two parts in a manner that the corrosion-protection element is positioned between the two metal parts; and

(c) expanding the corrosion-protection element at another point in the assembly process by application of heat.

It is abundantly clear, and pointed out previously, that Cleslik uses an expandable material to fill a void in parts already joined. In Cleslik the juncture, as understood and applied by the examiner, and circled in the copy of Cleslik's Fig. 2 provided in the action, is already joined, with the metal parts in contact, before the heat-expandable element is introduced. The metal parts in contact is part of the basis of the corrosion problem sought to be eliminated by the present invention. So the specification in claim 50, as amended, that the element is placed before the parts are joined, and positioned such that the element is between the parts, distinguishes rather nicely over Cleslik, and the form of the element as a limitation is no longer needed.

Claim 51-8, depended from claim 50 either directly or indirectly, are now patentable at least as depended from a patentable claim.

Claim 59 as last amended recites:

59. (Previously presented) A corrosion-protection element comprising a portion of heat-expandable material shaped to conform, **prior to expansion**, to a general shape of a

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juncture between two or more metal parts of an assembly, to fill the juncture when later expanded by heat.

Clesliks element is NOT shaped to conform to the shape of a juncture of elements prior to expansion. It is in the act of expansion that Cleslik's element fills the void as shown in Fig. 2 as provided by the examiner, not before.

Claim 59 is therefore patentable over Cleslik, and claims 60-67 are patentable at least as depended from a patentable claim.

Claim 68 is cancelled.

As all of the claims standing for examination have been shown clearly to be patentable over the art cited and applied, taken either singly or in combination, the applicant respectfully requests reconsideration, and that the case be passed quickly to issue.

If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Respectfully Submitted,
Reinhard List

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Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.
10/534,641

Applicant(s)
LIST, REINHARD

Art Unit
1700

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 31 October, 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: See Continuation Sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance, or a drawing submission (only). If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1 to 4 are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable Felicia Allen-Jenkins

Telephone No: 571-272-0686

U.S. Patent and Trademark Office
PTOL-324 (04-06)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Part of Paper No. 20071107

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Continuation of 4. Other: claim 55 status identifier is incorrect because there are no markings..

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